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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/036,185	12/28/2001	Michele Borgatti	32079-82	4873

7590   03/14/2005

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EXAMINER
MYERS, PAUL R

ART UNIT	PAPER NUMBER
2112	

DATE MAILED: 03/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	10/036,185	BORGATTI ET AL.
	Examiner	Art Unit	
	Paul R. Myers	2112	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>12 January 2005</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-11</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-11</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments with respect to claims 1-11 have been considered but are moot in

view of the new ground(s) of rejection.

In regards to applicants argument that Kamepalli does not teach the expansion module

comprising the "reconfigurable unit adapted to be in circuit modified to establish connections

within the module, implement a certain class of functions, and control the module components to

support the implemented class of functions": The previous examiner appeared to point to the

wrong item. In that the item that does the reconfiguring and not the item that is reconfigured was

pointed to. Each of the controllers F0-F7 are reconfigurable units.

In regards to applicants argument that Kamepalli does not teach the expansion unit

comprising "a software algorithm adapted to instruct the control device in the circuit

modification of the reconfigurable unit": It appears the previous examiner missed that the

comprising language for the expansion unit, and treated it in the comprising language of the

electronic system. Thus while the current examiner agrees that the electronic system that

includes the expansion unit does is reconfigured by a BIOS software algorithm, the Bois

algorithm does not appear to be stored within the expansion unit itself.

Claim Rejections - 35 USC § 103

2.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person

electronic device (e.g. col. 3, lines 11 et seq.); reading applications resident on the portable

electronic device (col. 5, lines 5 et seq.); upon receiving a request to activate a new function to

be provided by the portable electronic device (e.g. col. 6, lines 10-41), automatically

reconfiguring the expansion module to provide the new function requested (e.g. col. 6, lines 10-

41).

In regards to claim 3: "wherein the step of automatically reconfiguring comprises

verifying that the request is consistent with the functions that are capable of being provided by

the expansion module" is within the teachings of Kamepalli (see col. 3, line 65 - col. 4, line 19).

In regards to claims 4 and 6: "wherein the step of automatically reconfiguring comprises

selecting components within the expansion module to perform the new function requested, and

deselecting components within the expansion module that are not needed to perform the function

requested" is within the teachings of Kamepalli (see col. 4, lines 20-46).

In regards to claim 5: Kamepalli teaches signaling completion of the reconfiguring (e.g.

col. 5, line 65-col. 6, line 11).

Conclusion

4.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

WO 99/33243 to Leong teaches a reconfigurable expansion module as claimed

above excepting that the Host is not necessarily portable and the control program is

downloaded to the Expansion module.

PN 5,615,344 to Yanai et al teaches a reconfigurable adapter.

PN 4,868,783 to Anderson teaches a reconfigurable device adapter.

PN 5,247,633 to Nissimov teaches an adapter with its own extension BIOS.

WO 94/11802 to Corder teaches a reconfigurable adapter with its own stored

operations program.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Paul R. Myers whose telephone number is 571 272 3639. The

examiner can normally be reached on Mon-Thur 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Mark Rinehart can be reached on 571 272 3632. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PAUL R. MYERS
PRIMARY EXAMINER

PRM
March 9, 2005